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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/720,418	11/24/2003	Ray Skaggs	SKA839.0001	5111
34487	7590	04/19/2006		
BRENT A. CAPEHART LaRiviere, Grubman & Payne, LLP 19 Upper Ragsdale Drive, Suite 200 P.O Box 3140 Monterey, CA 93940			EXAMINER WARTALOWICZ, PAUL A	
			ART UNIT 1754	PAPER NUMBER
DATE MAILED: 04/19/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/720,418

Applicant(s)

SKAGGS, RAY

Examiner

Paul A. Wartalowicz

Art Unit

1754

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 4/10/06 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

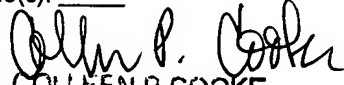
4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: _____.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☒ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
The rejections over the pending claims has been maintained.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s): _____.
13. ☐ Other: _____.


COLLEEN P. COOKE
PRIMARY EXAMINER

DETAILED ACTION

Repeated Rejections

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1, 3, 4, 6, 7, 10, 12, 13, and 15-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rylander (U.S. 4749011) in view of Steinmetz (U.S. 5884454) and Mezzanotte et al. (U.S. 3736973).

Rylander teaches a flexible plastic sheeting that has an initial flat configuration and constructed of a suitable material having the chemical and physical properties wherein the sheet may be readily manually deformed to a substantially cylindrical configuration of substantially any desired diameter which will return to its normal flat configuration upon the complete release of external pressures thereon (col. 1, lines 46-

58) and a plurality of gripping ridges at the top of the sheet (fig. 7, #42,44). Rylander fails to teach at least one memory retention unit being imbedded in said panel and constructed from a second material sufficiently flexible for responding to pressure thereon for deforming into said substantially cylindrical configuration and having sufficient memory characteristics for returning said panel body to its normal flat planar configuration when said pressure has been removed therefrom.

Steinmetz, however, teaches a resilient rod made from metal (col. 1, lines 52-55; col. 1, lines 63-64) that is imbedded in a trash bag (fig. 1, #21,28) for the purpose of stretching the bag open such that an arm load of trash may be placed within the circle (col. 1, lines 55-59). Therefore, it would have been obvious to one of ordinary skill in the art at the time applicant's invention was made to have provided the rod (fig. 1, #21,28) of Steinmetz in the plastic sheet (fig. 1, #14) of Rylander because it is well known that one or more metal cords can be imbedded in a polymer to strengthen and add rigidity as taught by Mezzanotte et al. (col. 3, lines 7-15) which provides a material that meets the requirements and purpose of Rylander.

As to claim 4, Rylander teaches that the flat body portion can be constructed from a suitable material having sufficient flexibility for rolling or forming thereof into a substantially cylindrical configuration, a sufficient memory characteristic for resisting taking a "set" in the rolled configuration thereof (col. 3, lines 10-18) but fails to teach the material which the article is constructed from is rubber. However, it would be obvious to one of ordinary skill in the art to use rubber material because rubber meets the material limitations.

As to claims 6, 13, and 15, Steinmetz teaches that the resilient rod can be constructed from a material which tries to straighten out, stretching the bag opening into a circle that can be made from many materials such as metal or plastic (col. 1, lines 52-55; col. 1, lines 63-64) but fails to teach that the material can comprise specifically spring steel or rubber. However, it would have been obvious to one of ordinary skill in the art to use spring steel or rubber because spring steel and rubber are metals or plastics that meet these limitations.

As to claims 17 and 18, Steinmetz teaches a resilient rod that is embedded in a trash bag and that the rod can comprise many materials such as metal or plastic (col. 1, lines 63-64; col. 2, lines 3-4). It would have been obvious to one of ordinary skill in the art to use rods having either a rectangular cross-section or a circular cross-section because Steinmetz is silent as to any particular cross-section being required and would therefore be open to such readily available rods.

Response to Arguments

Applicant's arguments filed on April 10, 2006 have been fully considered but they are not persuasive.

Applicant argues that there is no discussion, teaching or motivation to include a rod that is woven within the bag in Rylander plane, nor is there such discussion, teaching or motivation to include a flexible panel with the Steinmetz rod.

This argument is not persuasive for the following reason: The motivation for the combining of Rylander with Steinmetz stems from the teaching of Mezzanotte wherein it

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is well known that one or more metal cords can be imbedded in a polymer to strengthen and add rigidity as taught by Mezzanotte et al. (col. 3, lines 7-15). This teaching of Mezzanotte provides the motivation for the combining of polymer (polycarbonate, col. 3, lines 20-24) with the metal rod used for embedding (col. 1, lines 52-56) of Steinmetz.

Applicant argues that the combination of Rylander with Steinmetz would render the Rylander reference inoperable and could change of principle of operation of Steinmetz.

This argument is not persuasive for the following reason: Steinmetz teaches a resilient rod made from metal (col. 1, lines 52-55; col. 1, lines 63-64) that is imbedded in a trash bag (fig. 1, #21,28) for the purpose of stretching the bag open such that an arm load of trash may be placed within the circle (col. 1, lines 55-59). Mezzanotte teaches wherein it is well known that one or more metal cords can be imbedded in a polymer to strengthen and add rigidity as taught by Mezzanotte et al. (col. 3, lines 7-15). This teaching of Mezzanotte provides the motivation for combining the teaching of Steinmetz with the teaching of Rylander.

Applicant argues that to place the Steinmetz rod inside the Rylander panel would fundamentally change the operation of the Steinmetz rod, and that it would not be capable of being woven or inserted into the bag.

This argument is not persuasive for the following reason: The motivation for imbedding the rod of Steinmetz in the panel of Rylander is in Mezzanotte. Mezzanotte

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teaches wherein it is well known that one or more metal cords can be imbedded in a polymer to strengthen and add rigidity as taught by Mezzanotte et al. (col. 3, lines 7-15). The rod of Steinmetz can be imbedded into the panel of Rylander in this fashion.

Applicant argues that Mezzanotte is non-analogous art and thus is not a proper reference, and that Mezzanotte is not within the same classification as either the Rylander or Steinmetz references, and that this is some evidence of being non-analogous.

This argument is not persuasive for the following reason: Mezzanotte is a reference which is relied upon for the teaching wherein it is well known that one or more metal cords can be imbedded in a polymer to strengthen and add rigidity as taught by Mezzanotte et al. (col. 3, lines 7-15). Mezzanotte is only relied upon for this broad teaching of motivation to embed a metal rod in a polymer. It is immaterial that Mezzanotte is not classified with Rylander or Steinmetz. This is not evidence of non-analogous art. The broad teaching of motivation to embed a metal rod in a polymer is applicable to the combination of Rylander and Steinmetz such that Mezzanotte is relevant art.

Also, Mezzanotte solves a specific problem and therefore does not need to be in field of art of the inventor's endeavor as stated in MPEP 2141.01(a):

"A reference is reasonably pertinent if, even though it may be in a different field from that of the inventor's endeavor, it is one which, because of the matter with which it deals, logically would have commended itself to an inventor's attention in

considering his problem.” Wang Laboratories Inc. v. Toshiba Corp., 993 F.2d 858, 26 USPQ2d 1767 (Fed. Cir. 1993); and State Contracting & Eng'g Corp. v. Condotte America, Inc., 346 F.3d 1057, 1069, 68 USPQ2d 1481, 1490 (Fed. Cir. 2003).

Applicant argues that one of skill in the art, seeking to solve the problem of holding a trash or lawn bag open would not be expected or motivated to look toward the radial tire art.

This argument is not persuasive for the following reason: The Mezzanotte patent has the broad teaching wherein it is well known that one or more metal cords can be imbedded in a polymer to strengthen and add rigidity as taught by Mezzanotte et al. (col. 3, lines 7-15) such that the patent is drawn to illustrating that metal rods can be imbedded in a polymer structure to add rigidity. This is a broad teaching that can be applied across a wide spectrum of art to which it is of use. This teaching of motivation to embed a metal rod in a polymer to add rigidity is thus applicable in this case because Rylander teaches a polymer panel and Steinmetz teaches a metal rod used for embedding. The motivation to combine stems from Mezzanotte such that the broad teaching is applicable to the combination of Rylander and Steinmetz.

Mezzanotte solves a specific problem and therefore does not need to be in field of art of the inventor's endeavor as stated in MPEP 2141.01(a):

"A reference is reasonably pertinent if, even though it may be in a different field from that of the inventor's endeavor, it is one which, because of the matter with which it deals, logically would have commended itself to an inventor's attention in considering his problem." *Wang Laboratories Inc. v. Toshiba Corp.*, 993 F.2d 858, 26 USPQ2d 1767 (Fed. Cir. 1993); and *State Contracting & Eng'g Corp. v. Condotte America, Inc.*, 346 F.3d 1057, 1069, 68 USPQ2d 1481, 1490 (Fed. Cir. 2003).

Applicant argues that Mezzanotte does not teach the use of a flexible panel and that Mezzanotte teaches away from the use of a flexible metal within a polymer, and that one skilled in the art would not consider Mezzanotte in attempting to solve a problem relating to a flexible bag.

This argument is not persuasive for the following reason: Mezzanotte is not relied upon to teach a flexible metal, Mezzanotte is relied upon to teach wherein it is well known that one or more metal cords can be imbedded in a polymer to strengthen and add rigidity.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

As to the affidavit of Mr. Nick Rylander, applicant argues that the actual inventor of the Rylander reference, after reviewing the Steinmetz reference, has concluded that it would not be obvious to combine his reference with Steinmetz and that he deems "it not all obvious to combine the designs of Rylander and Steinmetz."

This argument is not persuasive for the following reason: The statement that Mr. Nick Rylander deems "it not all obvious to combine the designs of Rylander and Steinmetz" is just a statement without any proof or evidence (experiments, unexpected results, etc.) for justification or verification therein. In the affidavit, Mr. Nick Rylander describes some embodiments of the Rylander and Steinmetz patent, and then comes to the conclusion the combination is not obvious. Also, the affidavit does not mention the Mezzanotte reference and how the motivation from the Mezzanotte reference is combined with the teachings of Rylander and Steinmetz. Mr. Nick Rylander also comments in the affidavit that he "take(s) issue with the following statements in the Skaggs application", this paragraph is not relevant with respect to the rejections over the claims.

In conclusion, the rejection of the claims afore mentioned is maintained.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul A. Wartalowicz whose telephone number is (571) 272-5957. The examiner can normally be reached on 8:30-6 M-Th and 8:30-5 on Alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stanley Silverman can be reached on (571) 272-1358. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Paul Wartalowicz
April 14, 2006